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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,054	06/27/2003	Michael L.F. Chan	TRA-007	7895
3897	7590	10/11/2005	EXAMINER	
SCHNECK & SCHNECK P.O. BOX 2-E SAN JOSE, CA 95109-0005			MILLER, BENA B	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/608,054

Applicant(s)

CHAN, MICHAEL L.F.

Examiner

Bena Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*Bena B. Miller*

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is not clear whether the transparent top and bottom sections are the same as the transparent surface.

Regarding claim 2, there is lack of antecedent basis for the limitation "the window".

Regarding claim 7, claim 1 recites the top and bottom sections are transparent; however, the claim recites the box is entirely transparent. It is not clear if the top and bottom sections or the entire box is transparent.

For the purposes of this Office Action, the Examiner presumes that the gift holding box has a transparent surface.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Holtkamp, Jr. (US 5,038,930).

The device of Holtkamp, Jr. reads on the structural limitations of the claims including a gift holding box having a transparent surface (28), a mailing box having a cutout (10, fig. 3;), a removable opaque panel (36; It should be noted that panel 36 is inside the mailing box once covered by 34) and a display panel (22).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holtkamp, Jr. (US 5,038,930).

Holtkamp teaches in the figures most of the elements of the claimed invention except for a metal sculpture mounted on the display panel. At the time the invention was made, it would have been an obvious matter of design choice to a persons of ordinary skill in the art to have a metal sculpture mounted on the display panel of Holtkamp because Applicant has not disclosed that the metal sculpture provides an advantage, is used for a particular purpose, or solves a stated problem.

Claims 1, 4-7 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ames (US Patent 610,337) in view of Sogaard (US Patent 6,409,568), Parsons (US Patent 6,398,026) or Hinz (US Patent 2,636,597).

Ames teaches in the figures most of the elements of the disclosed invention, including a gift holding box (B), a mailing box having a cutout (D), a removable opaque panel (E) and printing on the removable opaque panel and mailing box (fig. 1). However, Ames fails to teach the gift box having a transparent surface and a meter stamp and stamp disposed on the opaque panel. Ames teaches that address card E has a space e for a postage stamp. Therefore, it would have been obvious to one having ordinary skill in the art to dispose a meter stamp and a stamp on the device of Ames for the purpose of the mailing the gift.

Sogaard, Parsons and Hinz teach a gift holding box that is transparent (7, 12 and 14 or 10, respectively). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the gift holding box of Ames transparent as suggested by Sogaard, Parsons or Hinz for the purpose of viewing the contents therein.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ames (US Patent 610,337) in view of Hinz (US Patent 2,636,597).

Ames teaches in the figures most of the elements of the disclosed invention except for a display panel and metal sculpture. Hinz teaches a gift holding box having display panel (30) with a doll mounted thereon (fig.1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a

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display panel as suggested by Hinz in the gift holding box of Ames for the purpose of allowing a content to be visible when stored. At the time the invention was made, it would have been an obvious matter of design choice to persons of ordinary skill in the art to have a metal sculpture mounted on the display panel because Applicant has not disclosed that metal sculpture provides an advantage, is used for a particular purpose, or solves a stated problem.

Claims 1 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schluger (US Patent 5,232,087) in view of Sogaard (US Patent 6,409,568), Parsons (US Patent 6,398,026) or Hinz (US Patent 2,636,597).

Schluger teaches in the figures most of the elements of the disclosed invention, including a gift holding box (12), a mailing box having a cutout (30), a removable opaque panel (22; Note, 22 is within the mailing box once enclosed by 80, 82, 84 and 86—fig. 9) and printing on the removable opaque panel and mailing box (fig. 3 and 4). However, Schluger fails to teach the gift box having a transparent surface. Sogaard, Parsons and Hinz teach a gift holding box that is transparent (7, 12 and 14 or 10, respectively). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the gift holding box of Schluger transparent as suggested by Sogaard, Parsons or Hinz for the purpose of viewing the contents therein.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ames (US Patent 610,337) and Sogaard (US Patent 6,409,568), Parsons (US Patent 6,398,026) or Hinz (US Patent 2,636,597) as applied to claim 1 above, and further in view of Plotkin (US 5,526,597).

Ames and Sogaard, Parsons or Hinz teaches most of the elements of the claimed invention except for a card and an envelope. Plotkin teaches a box having a card (60) and envelope (26) contained therein. It would have been obvious to one having ordinary skill in the art at the time the invention was made to put a card and envelope as suggest by Plotkin in the device of Ames and Sogaard, Parsons or Hinz for the purpose of providing a greeting card for an individual.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schluger (US Patent 5,232,087) and Sogaard (US Patent 6,409,568), Parsons (US Patent 6,398,026) or Hinz (US Patent 2,636,597) as applied to claim 1 above, and further in view of Plotkin (US 5,526,597).

Schluger and Sogaard, Parsons or Hinz teaches most of the elements of the claimed invention except for a card and an envelope. Plotkin teaches a box having a card (60) and envelope (26) contained therein. It would have been obvious to one having ordinary skill in the art at the time the invention was made to put a card and envelope as suggest by Plotkin in the device of Schluger and Sogaard, Parsons or Hinz for the purpose of providing a greeting card for an individual.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

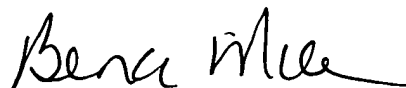
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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on \*\*\*\*\*. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bena Miller  
Primary Examiner  
Art Unit 3725

bbm  
October 6, 2005